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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,804	04/25/2000	Roger Bruce Harding	1313/1F022-US1	8941

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Darby & Darby PC
805 Third Avenue
New York, NY 10022

EXAMINER

WHITE, EVERETT NMN

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 02/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/557,804

Applicant(s)

HARDING ET AL.

Examiner

EVERETT WHITE

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 1-38 and 40-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5-7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-38, 59, drawn to a method of preparing cellulose ethers, classified in class 106, subclass 172 plus.
 - II. Claims 39 -46, drawn to carboxymethyl cellulose ether, methyl cellulose ether, nonionic cellulose ether, and ionic cellulose ether, classified in class 536, subclass 84 plus.
 - III. Claims 47-58, drawn to cellulose floc and method of preparing cellulose floc, classified in Class 536, subclass 73.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make a materially different product such as the different products disclosed in the instant claims such as the carboxymethyl cellulose ether, methyl cellulose ether, a nonionic cellulose ether or a ionic cellulose ether. Each of these cellulose ether products are materially different and distinct.
3. Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process for preparing cellulose ethers does not require the preparation of cellulose floc. It is well known in the art that cellulose pulp can be treated to produce cellulose ethers without the preparation of cellulose floc as an intermediate material.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the search required for Group II is not required for Groups I and III, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Election of Species

5. Claims 1-9, 47-52 and 59 are generic to a plurality of disclosed patentably distinct species comprising cotton linters pulps; sulfite cellulose pulps; rehydrated cellulose pulps; and the various types of hardwood, softwood and kraft cellulose pulps set forth in Claims 3 and 4. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

6. Claims 35-46 are also generic to a plurality of disclosed patentably distinct species comprising carboxymethyl cellulose; methyl cellulose; nonionic ether; and ionic ether, cotton linter pulp derived carboxymethyl cellulose; softwood kraft pulp derived carboxymethyl cellulose; hardwood kraft pulp derived carboxymethyl cellulose; and wood pulp derived carboxymethyl cellulose. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

7. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. During a telephone conversation with Mr. Jay P. Lessler on February 6, 2002 a provisional election was made with traverse to prosecute the invention of Group II, claims 39-46, and carboxymethyl cellulose as the elected species. Affirmation of this election must be made by

applicant in replying to this Office action. Claims 1-38 and 47-59 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. Claim 39 is rejected under 35 U.S.C. 102(a) as being anticipated by Mansikkamaki et al (EP 0879827).

Applicants claim a carboxymethyl cellulose ether in the form of a product-by-process claim.

The Mansikkamaki et al patent discloses carboxymethyl cellulose which preparation involves mercerizing the reaction medium with an aqueous solution of NaOH (see abstract). See Table 2 on page 3 of the Mansikkamaki et al patent wherein the viscosity of various preparation of carboxymethyl cellulose is disclosed. All the viscosity values disclosed in the table are greater than 12 cP (see this limitation in instant Claim 1). Applicants are reminded that process limitations cannot impart patentability to a product which is not patentably distinguished over the prior art. The carboxymethyl cellulose product of the Mansikkamaki et al patent anticipates the instantly claimed carboxymethyl cellulose product of instant Claim 39.

12. Claims 40-46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the election requirement during the telephone conversation with Jay P. Lessler on February 6, 2002.

Summary

13. Claim 39 is rejected; Claims 40-46 are withdrawn as being directed to nonelected species; Claims 1-38 and 47-59 are withdrawn from consideration as being directed to nonelected inventions.

Examiner's Telephone Number, Fax Number, and Other Information

14. For 24 hour access to patent application information 7 days per week, or for filing applications electronically, please visit our website at www.uspto.gov and click on the button "Patent Electronic Business Center" for more information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist, can be reached on (703) 308-1701. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

E. White
White

February 7, 2002


GARY GEIST
SUPERVISORY PATENT EXAMINER
TECH CENTER 1600